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Docket No.: 28079/41785
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
David A. Fischhoff et al.

Confirmation No.: 2627

Application No.: 08/434,105

Group Art Unit: 1638

Filed: May 3, 1995

Examiner: A. R. Kubelik

For: **SYNTHETIC PLANT GENES AND METHOD
FOR PREPARATION**

**PETITION TO EXPUNGE PAPERS FROM FILE
PURSUANT TO 37 CFR 1.59 (MPEP 724.05)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attn: TC1600

Dear Madam:

The applicants hereby identify the Documents filed as part of the accompanying Information Disclosure Statement ("IDS" and complete list of documents attached hereto) as the subject of this conditional petition to expunge pursuant to 37 C.F.R. §1.59.

These Documents to be expunged are subject to one or more protective orders, and have not otherwise been made public. The documents have been packaged and labeled in accordance with MPEP 724.02.

The Applicants commit to retain the Documents for the period of any patent issued on the above-mentioned application with regard to which the Documents are presently submitted.

The petition to expunge is being submitted by (on behalf of) the party in interest, Monsanto Company, St. Louis, MO, who originally caused the Documents to be submitted.

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The Director is therefore petitioned under 37 C.F.R. 1.59 to expunge the Documents IF THE DOCUMENTS ARE FOUND NOT TO BE IMPORTANT TO A REASONABLE EXAMINER IN DECIDING WHETHER TO ALLOW THE APPLICATION TO ISSUE AS A PATENT. The Applicants request that the evaluation of the importance of each document (and whether it may properly be expunged) be made individually. Applicants understand that this petition will be held in abeyance until the close of prosecution on the merits (MPEP 724.05 (I) and 724.06).

The fee for this petition in the amount of \$200.00 according to 37 C.F.R. 1.17(g) may be charged to our Deposit Account No. 13-2855, under Order No. 28079/41785.

Dated: May 29, 2009

Respectfully submitted,

By 
David A. Gass
Registration No.: 38,153
MARSHALL, GERSTEIN & BORUN LLP
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Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicants



PTO/SB/08b (04-09)

Approved for use through 05/31/2009. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO				<i>Complete if Known</i>	
				Application Number	08/434,105-Conf. #2627
				Filing Date	May 3, 1995
				First Named Inventor	David A. Fischhoff
				Art Unit	1638
				Examiner Name	A. R. Kubelik
Sheet	1	of	1	Attorney Docket Number	28079/41785

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number Number-Kind Code ² (<i>if known</i>)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Foreign Patent Document Country Code ³ -Number ⁴ -Kind Code ⁵ (<i>if known</i>)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear
					T ⁶

NON PATENT LITERATURE DOCUMENTS					
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.			
	C323	Transcript, Deposition Testimony of Elizabeth Fowler, pages 1-276, dated January 12, 2004, as filed in <i>Syngenta Seeds v. Monsanto Co. et al.</i> , C.A. No. 02-1331 (SLR), United States Court District of Delaware.			
	C324	Exhibit 4 of Deposition Testimony of Elizabeth Fowler, Bates Nos. CGD 072284-294, as filed in <i>Syngenta Seeds v. Monsanto Co. et al.</i> , C.A. No. 02-1331 (SLR), United States Court District of Delaware.			
	C325	Exhibit 6 of Deposition Testimony of Elizabeth Fowler, Bates Nos. SSC126679-712, as filed in <i>Syngenta Seeds v. Monsanto Co. et al.</i> , C.A. No. 02-1331 (SLR), United States Court District of Delaware.			
	C326	Exhibit 8 of Deposition Testimony of Elizabeth Fowler, Bates Nos. SSC126788-790, as filed in <i>Syngenta Seeds v. Monsanto Co. et al.</i> , C.A. No. 02-1331 (SLR), United States Court District of Delaware.			
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Examiner Signature	Date Considered
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.



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Application No.: 08/434,105

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METHOD FOR PREPARATION**

Examiner: A. R. Kubelik

INFORMATION DISCLOSURE STATEMENT WITH DOCUMENTS UNDER SEAL

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

Applicants request that this Information Disclosure Statement ("IDS") be entered and that the IDS and documents listed in it be considered by the examiner during the prosecution of this application. A copy of each listed document is being submitted under seal in an envelope with the following label appended thereto:

MATERIAL SUBJECT TO PROTECTIVE ORDER
NOT OPEN TO THE PUBLIC – TO BE OPENED ONLY BY
EXAMINER OR OTHER AUTHORIZED U.S.PATENT AND
TRADEMARK OFFICE EMPLOYEE.

DO NOT SCAN.

Tribunal Issuing Protective Order: U.S. District Court for the
District of Delaware, Civil Action or Other Identification No.
02-1331 (SLR), Syngenta Seeds, Inc. v. Monsanto Co. et al.

Date of Order: June 27, 2003,

Current Status of Proceedings: Concluded

In re Application of: Fischoff, David A.

Application No. 08/434,105

Filed: May 3, 1995

For: Synthetic Plant Genes and Method for Preparation,

TC Art Unit: 1638 Examiner: KUBELIK, Anne.

The documents of this IDS are subject to a protective order entered in a prior litigation, and are being submitted under seal for consideration by the Examiner under MPEP § 724, without scanning or publication by the USPTO. These documents are labeled in accordance with MPEP § 724, as noted above, and are identified in the attached Form SB-08. Applicants also submit a petition and fee under 37 CFR § 1.59, requesting that these documents be expunged from the file.

The IDS filed in this matter on December 15, 2006, made U.S. Patent 6,689,356 (Zlotkin et al.) of record. In addition, the IDS filed on December 20, 2006, made Australian Patent Nos. AU-B-36568/89 and AU-B-46881/89 (Ciba-Geigy AG) of record. The documents cited in this IDS are transcripts of deposition testimony of Elizabeth Fowler and related deposition exhibits; Elizabeth Fowler is a named inventor of the '356 Zlotkin et al. patent. The deposition was taken by Monsanto litigation counsel on January 12, 2004, in *Syngenta Seeds, Inc. v. Monsanto Co.*, C.A. No. 02-1331 (SLR) in the Delaware District Court.

This IDS is filed after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Office Action or Notice of Allowance (37 CFR 1.97(c)). Accordingly, our payment of \$180.00, covering the fee set forth in 37 CFR 1.17 (p) is enclosed. Should any fees under 37 CFR §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Director is authorized to deduct said fees from our Deposit Account No. 13-2855, under Order No. 28079/41785.

Dated: May 29, 2009

Respectfully submitted,

By 
David A. Gass
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